

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

FISCHER *et al.*

Appl. No.: 10/567,788

§ 371(c) Date: February 16, 2007

For: **4-Biphenyl-Substituted
Pyrazolidin-3,5-Dione Derivatives**

Confirmation No.: 2694

Art Unit: 1626

Examiner: CHU, Yong Liang

Atty. Docket: 2400.0210000/VLC/CMB/CBF

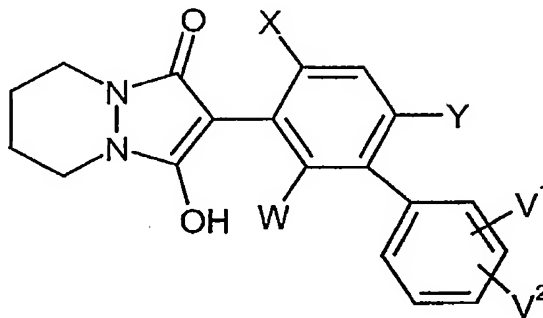
Reply to Restriction Requirement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated September 23, 2008, requesting an election of one invention to prosecute in the above-referenced patent application, Applicant hereby provisionally elects to prosecute the invention of Group II, represented by claims 1-14, and 19-21.

The Office has also required Applicant to elect a single species for search purposes. Applicants provisionally elect compound I-1-a-2 as a single species. The structure of compound I-1-a-2 is:



Wherein W is H, X is CH₃, Y is H, V¹ is 2-Cl, and V² is H.

This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse.

Special Technical Feature

This application is a National Phase Entry under 35 U.S.C. § 371 and, as such, PCT Rule 13 requiring unity of invention applies. Title 37 of the Code of Federal Regulations states:

(a) An international and national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. *The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.*

37 C.F.R. § 1.475 (a) (emphasis added). The Examiner has stated that a compound of formula (I) is not a special technical feature, because it fails to define a contribution over the prior art. Applicant respectfully disagrees, and directs attention to section 1850 of the Manual for Patenting Examining Procedure, which states:

Although lack of unity of invention should be raised in clear cases, it should neither be raised nor maintained on the basis of narrow, literal, or academic approach. For determining the action to be taken by the examiner...rigid rules cannot be given and each case should be considered on its merits, *the benefit of any doubt being given to the applicant.* (emphasis added)
MPEP § 1850 (II)(paragraph 4).

The claims of the instant application do not qualify as a "clear case" of lacking unity of invention. Each claim shares the special technical feature of a compound of formula (I); a compound of formula (I) represents a contribution over the prior art. As stated above the benefit of *any* doubt with respect to unity of invention must be given to the applicant. Applicants therefore respectfully submit that a compound of formula (I) represents a special technical feature and unity of invention exists between the claims of Groups I, II, III and IV.

The Examiner has also argued that a compound of formula (I) is rendered instantly obvious by the reference WO 2001/017973 (Maetzke, *et. al.*). Applicant respectfully disagrees, noting that a Restriction Requirement is not an Office Action on the merits, and thus, an obviousness rejection is improper. Furthermore, Applicant directs attention towards section 2143 of the Manual of Patenting Examining Procedure, which states:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reasons why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. MPEP § 2143 (paragraph 1).

Applicant respectfully submits that the Examiner has neither articulated reasons why a compound of formula (I) would have been obvious, nor has the Examiner explicitly supported their analysis. Therefore, Applicant submits that the Examiner has not met their burden of proof required to establish a *prima facie* case of obviousness under 35 U.S.C. §103, and all such arguments should be withdrawn.

Unity of Invention

This application is a National Phase Entry under 35 U.S.C. § 371 and, as such, PCT Rule 13 requiring unity of invention applies. Title 37 of the Code of Federal Regulations states:

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) *A product and a process specially adapted for the manufacture of said product; or*

(2) *A product and a process of use of said product;*

37 C.F.R. § 1.475 (b)(1)-(2) (emphasis added).

The claims of Groups I and II identified by the Office are directed to products, i.e., the compounds and compositions of claims 1-14 and 19-21. The claims of Group III identified by the Examiner are directed to processes of use of the product, i.e., use of compounds of formula (I) according to Claim 1 for controlling animal pests, unwanted vegetation and/or unwanted microorganisms. The claims of Group IV identified by the office are directed towards processes specially adapted for the manufacture of said product, i.e., process for preparing compositions for controlling pests, unwanted vegetation and/or unwanted microorganisms, characterized in that compounds of the formula (I) according to Claim 1 are mixed with extenders and/or surfactants.

As noted, 37 C.F.R. § 1.475 (b)(1) states that a national stage application containing claims to a product and a process specially adapted for the manufacture of said product will be considered to have unity of invention. Furthermore, 37 C.F.R. § 1.475 (b)(2) states that a national stage application containing claims to a product and a

process of use of said product will be considered to have unity of invention. Applicants therefore respectfully assert that the claims of Groups I, II, III and IV share unity of invention and the Restriction Requirement is improper.

Request for Rejoinder

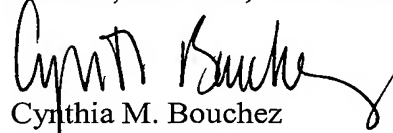
The Examiner has required restriction amongst Groups I, II, III and IV. In accordance with MPEP § 821.04(a) a requirement for restriction should be withdrawn when a subcombination claim is allowable and any previously withdrawn claim that depends from or otherwise requires all the limitations of the subcombination should be rejoined. Applicants respectfully request that if the restriction requirement is made final and the claims of Group I, directed to a compound of the formula (I), are found allowable, that the claims of Groups II, III and IV, directed to compounds, methods of use of compounds, and processes for preparing compounds of the formula (I), be rejoined and examined for patentability. *See* M.P.E.P. § 821.04(a).

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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